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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,369	08/17/2000	Victoria J. Freeman	0065292	5206

7590 06/26/2002

KAUFMAN & CANOLES  
ATTN: PETER A SHADDOCK II  
ONE COMMERCIAL PLACE  
P O BOX 3037  
NORFOLK, VA 23514

EXAMINER

ASHBURN, STEVEN L

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 06/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/640,369

Applicant(s)

FREEMAN, VICTORIA J. 

Examiner

Steven Ashburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

  
MARK SAGER  
PRIMARY EXAMINER**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## ***DETAILED ACTION***

### ***Drawings***

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### ***Claim Objections***

The claims are objected to because they include reference characters corresponding to elements or steps enclosed within parentheses. MPEP § 608.01(m) states:

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims.

Thus, the claims are objected to because the reference characters linking the claims are not considered within the scope of the claims. The claims should be rewritten to incorporate the referenced elements or steps without the parenthetical references.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the limitation, "playing pieces that are represented in a computer form that can be displayed on a computer screen". The term "computer form" fails to distinctly define the claimed subject matter because it may be interpreted as either a physical shape or computer executable instructions.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 12-17 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by *Peppel*, U.S. Patent 6,200,216 B1 (Mar. 13, 2001). *See e.g. fig. 2-6; col. 7:49-8:27, 10:46-58.*

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-4, 6-11 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Peppel* in view of *McGuire*, U.S. Patent 1,379,871 (May 31, 1921) and *Schoolfield*, U.S. Patent 1,991,468 (Feb. 19, 1935).

*Peppel* discloses an electronic trading card system in which players compete to collect sets of cards. The reference discloses the following features of the claimed subject matter:

- a. Dividing a theme comprising a correctly ordered sequence into a plurality of distinct parts, each part having no readily identifiable means for determining the correct sequence of the completed theme. *See* 3:33-57, 10:46-58, 12:22-48. (*Claims 1, 18*)
- b. Creating a plurality of playing pieces, each piece comprising one of the distinct parts. *See col. 6:11-18*.
- c. Distributing the plurality of playing pieces to members of the public. *See fig. 6; 5:51-57*.
- d. In response to receiving a correctly ordered set of playing pieces that represent a correctly ordered sequence, awarding a prize. *See col. 7:58-8:27*.
- e. Creating playing pieces comprising an advertisement. *See col. 5:12-32, 7:48-57, 10:46-58. (Claims 2)*
- f. Creating playing pieces comprising an advertisement having no apparent relationship to the theme. *See id. (Claims 3)*
- g. Creating playing pieces comprising a card having one of the distinct parts associated with an advertisement. *See id. (Claims 4, 7, 13)*
- h. Creating playing pieces that are represented in computer form that can be displayed on a computer screen and distributing the playing pieces through the Internet. *See id. (Claims 6, 18)*

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- i. Distributing only some of the playing pieces during a first time period, then distributing remaining playing pieces during a later time period. *See col. 6:19-53, 8:27-37. (Claims 8, 22)*
- j. Distributing “helper” playing pieces that contain information regarding the correct sequence of one or more of the playing pieces. *See fig. 4; col. 7:61-8:5, 9:23-30, 11:6-8, 11:37-41, 12:22-48. (Claims 9, 19)*
- k. Intermittently displaying the playing pieces on each of a plurality of web sites. *See col. 6:19-52, 7:58-8:54. (Claims 10, 20)*
- l. Creating playing pieces each comprising an identifier that identifies the playing piece without identifying the correct sequence of playing pieces. *See col. 5:14-17. (Claims 18)*
- m. Distributing additional playing pieces by giving them away in physical form rather than through web sites. *See 5:51-57, 8:17-37. (Claim 21)*

As listed above, *Peppel* discloses all the features of the claimed subject matter except a creating game pieces based on literary works comprising a correctly ordered sequence of words. Regardless of the deficiencies, these features would have been obvious to an artisan at the time the invention was made in view of *McGuire* and *Schoolfield*.

*McGuire* discloses a puzzle game employing playing pieces that represent distinct parts of a complete plot, theme or story, wherein the plurality of playing pieces contain no readily identifiable means for determining the correct sequence. *See p. 1, lines 9-30.* To complete the game, the player must assemble the cards in their correctly ordered sequence. *See p. 1, lines 30-35.* *McGuire* teaches assembling a stories from a set of cards to offer an entertaining puzzle game requiring thought, judgment and imagination. *See p. 2, lines 32-38.*

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*Schoolfield* discloses an analogous game wherein a plurality of legends, stories, poems, books and other forms of literature are selected and scenes drawn from the literature are depicted on cards. Hence, *Schoolfield* suggests assembling sets of cards based on literary work comprising a correctly ordered sequence of words.

In view of *McGuire* and *Schoolfield*, it would have been obvious to an artisan at the time of the invention to modify the electronic card collecting system disclosed by *Peppel*, wherein players assemble associated sets of cards representing portions of a theme into complete sets to earn awards, to employ cards containing ordered portions of stories taken from literary works. The modification would enhance the thought, judgment and imagination required for *Peppel's* collection games and thereby enhance the players' enjoyment by employing cards based on popular, familiar literature.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Peppel* in view of *McGuire* and *Schoolfield*, as applied to claims 1-4, 6-11 and 18-22 above, in further view of *Naeve*, U.S. Patent 4,309,835 (Jan. 12, 1982).

The trading card system suggested by the combination of *Peppel* with *McGuire* and *Schoolfield* describes all the features of the claimed subject matter except playing pieces that have a distinct part on one side and an advertisement on the other side. Regardless of the deficiency, this feature would have been obvious to an artisan at the time the invention was made in view of *Naeve*.

*Naeve* discloses a system for distributing promotional items such as trading cards. The reference discloses that it is known at the time of the invention to include advertisements on the trading cards such that the advertisements are obscured when the trading card is displayed in order to increase the card's value to the consumer. *See col. 1:28-38*. Thus, *Naeve* suggests creating trading cards containing advertisements wherein the card face is not obscured by the advertisement.

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In view of *Naeve*, it would have been obvious to an artisan at the time of the invention to modify the collection game system suggested by the combination of *Peppel* with *McGuire* and *Schoolfield*, wherein game pieces contain both distinct parts and advertisements, to place the advertising on the other side of the card from the distinct parts so that the advertisement does not obscure the game theme and thereby yield greater value to the collector.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703 308 4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9302 for regular communications and 703 872 9303 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.



Steven Ashburn.  
June 16, 2002



MARK SAGER  
PRIMARY EXAMINER